

REMARKS

Rejections in Light of U.S. Patent No. 6,470,085 to Uranaka et al.

The Examiner has rejected claims 1, 3, 4, 6, 8, 9, and 12-14 "under 35 U.S.C. 102(e) as being anticipated by Uranaka et al., US Patent Number 6,470,085, hereinafter Uranaka." *Office Action*, 2. The Applicant respectfully traverses as set forth herein.

Claim 1 of the present application, which has yet to be amended, recites:

A system for use in a network, comprising:

a user console;

a disc storage medium including a permanently recorded disc identification, the disc storage medium being readable by the user console, wherein the user console is operable to transmit the disc identification over the network; and

a host server in the network, the host server being configured to receive the disc identification and configured to assign points to a point account associated with the disc identification.

The Examiner contends, *inter alia*, that Uranaka discloses "a disc storage medium" "including a permanently recorded disc identification." *Office Action*, 3. The Examiner refers to DVD 3; column 2, lines 60-64; and column 5, lines 20-23 as purportedly evidencing this element of the Applicant's original claim 1. The Applicant respectfully disagrees with the Examiner's present contention.

Uranaka, as cited by the Examiner, refers to "the identifier (ID) code of a user specified application which is recorded on the DVD to the server." *Uranaka*, col. 2, l. 62-64 (emphasis added). The server of *Uranaka*, upon receipt of the ID code, "tests if [a] use-limiting factor associated with the user specified application is within [a] preset limit." *Uranaka*, col. 2, l. 64-66 (emphasis added). The ID code of *Uranaka* is not associated with a disc storage medium as is the case in Applicant's original claim 1 but is, instead, associated with an application (e.g., software) on the disc. This ID-to-application association in *Uranaka* is explicit; thus *Uranaka* fails to disclose the presently claimed 'permanently recorded disc identification.'

The Examiner's second citation to *Uranaka*—column 5, lines 20-23—also fails to disclose the Applicant's presently claimed 'permanently recorded disc identification.' The Examiner's second reference to *Uranaka* does nothing more than reference an "application package 20 compris[ing] at least one application 21," that package being recorded on DVD 3 as discussed above. *Uranaka*, col. 5, L 20-25. Again, the application package is associated with the aforementioned ID—not the disc storage medium itself.

The Applicant refers the Examiner to the *Abstract* of the *Uranaka* reference with regard to further support for the argument that *Uranaka* is concerned with access (and associated identification) of an *application* and *not* the *disc medium*. *Uranaka* purportedly provides "[a] system for permitting only an authentic user to play a desired *application* contained in a distributed *application package* in one of predetermined operation." *Uranaka, Abstract* (emphasis added). The aforementioned application associated ID allows for predetermined access to that application. As such, the Applicant again contends *Uranaka* as cited by the Examiner fails to disclose the recited 'disc identification' element.

In light of the present argument, *Uranaka* fails to disclose each and every element of claim 1, including but not limited to a permanently recorded disc identification. "A claim is anticipated only if each *and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). As *Uranaka* fails to disclose each and every element, the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) is overcome.

Further, the Applicants believe each and every dependent claim of the present application to be allowable over *Uranaka* regardless of whether it has been rejected under 35 U.S.C. § 102 or 35 U.S.C. § 103. As noted by 35 U.S.C. § 112, ¶ 4, "[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." As each dependent claim of the present application depends from claim 1 (either directly or via another dependent claim), each dependent claim thus fails to exhibit, at least, permanently recorded disc identification. The Applicant also

notes that if an independent claim is non-obvious under 35 U.S.C. § 103 (as is the case here), then any claim depending therefrom is also non-obvious. See *In re Fine*, 837 F.2d 1071 (Fed. Clr. 1988). As such, the Applicants contend the Examiner's rejection of the dependent claims of the present application to also have been overcome.

Applications Up for Third Action and Five-Year Applications

The Applicant respectfully notes that the present application was filed June 28, 2001. Any further action by the Patent Office will likely occur after the five-year anniversary of the aforementioned 2001 date. As such, the present application will be into its *fifth* year of prosecution upon receipt of any further action by the Patent Office.

Further, the Applicant notes that any further rejection will constitute a *fifth* official action from the Patent Office, all issued by the same Examiner. To review, a restriction requirement (first action) was issued by the Examiner in November 2004. Following an election by the Applicant, the Examiner issued a non-final rejection (second action) on April 28, 2005. This second action included a 35 U.S.C. § 102(e) rejection of independent claim 1 over U.S. patent publication number 2002-0104019.

In response, the Applicant differentiated the '019 publication and also noted the applicability of 35 U.S.C. § 103(c) so that the Examiner did not subsequently issue a 35 U.S.C. § 103(a) rejection based on the '019 publication. Notwithstanding the Applicant having made note of the applicability of 35 U.S.C. § 103(c), the Examiner proceeded to issue a 35 U.S.C. § 103(a) rejection in a new non-final action (third action) on October 14, 2005. The third action utilized the aforementioned and commonly owned '019 publication in spite of the Applicant's preemptive efforts to avoid an unnecessary rejection.

The Applicant, in response, again addressed the applicability of 35 U.S.C. § 103(c). The Examiner proceeded to withdraw the rejection and issue the present non-final action (fourth action) on March 28, 2006. The present action is again based on 35 U.S.C. § 102(e) with regard to the aforementioned *Uranaka* reference. As noted, any

subsequent action in response to the present reply will constitute a *fifth* action by the Patent Office.

The Applicant respectfully addresses Section 707.02 of the Manual of Patent Examining Procedure as it pertains to *Applications Up for Third Action and 5-Year Applications*. Section 707.02 notes that “the shortest path to the final disposition of an application is by finding the best references on the *first search* and carefully applying them.” MPEP § 707.02 (emphasis added). Notwithstanding the Examiner’s application of the aforementioned ‘019 publication in contravention of 35 U.S.C. § 103(c), the present rejection is, again, a 35 U.S.C. § 102(e) based on a reference (*Uranaka*) that published in 2002 and that has otherwise been accessible since the first substantive action on the merits.

The Applicant notes that “[a]ny application that has been pending five years should be carefully studied . . . and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered ‘special’ by the examiner.” MPEP § 707.02. Thus, the Applicant not only respectfully requests that the present application receive expedited further action as provided for by MPEP § 708.01(I) but that the Examiner give additional consideration to the three substantive rejections that have yet to evidence the anticipation and/or obviousness of the presently claimed invention by any of the references of record. While the Applicant appreciates the thoroughness of the present examination, the Applicant further believes that the lack of anticipation and/or obviousness strongly suggests the propriety of a *Notice of Allowance* in a subsequent action by the Examiner.

CONCLUSION

The Applicant has distinguished independent claim 1 from the cited *Uranaka* reference that fails to disclose, at the least, permanent disc identification. The Applicant therefore contends that claim 1 is allowable over the cited art of record. As all dependent claims ultimately rely upon allowable claim 1, the Applicant further contends all dependent claims to be in condition for allowance.

The Applicant further notes the five-year/three-action status of the present application. As such, the Applicant respectfully requests expedited handling with regard to any further action by the Examiner.

Notwithstanding, and based on the foregoing remarks, the Applicant respectfully requests the Examiner issue a *Notice of Allowance* for the present application. If the Examiner has any questions concerning the present response, *the Examiner is strongly encouraged to contact the Applicant's undersigned representative at the number given below in order to expedite the allowance of the present application.*

Respectfully submitted,
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